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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/621,953 | 07/17/2003 | Brian Bidlingmeyer | 10020542-1 | 1544 |

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| | |
|--------------------|--------------|
| EXAMINER | |
| THERKORN, ERNEST G | |
| ART UNIT | PAPER NUMBER |
| 1723 | |

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,953

Applicant(s)

BIDLINGMEYER ET AL.

Examiner

Ernest G. Therkorn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15, 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilar (Analytical Biochemistry 298, 196-206 (2001)) in view of A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 and Gjerde (U.S. Patent Pub. 2002/0185441). At best, the claims differ from Gilar (Analytical Biochemistry 298, 196-206 (2001)) in reciting use of an additive. Gjerde (U.S. Patent Pub. 2002/0185441) discloses that EDTA is an additive that can protect and restore a column. A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 evidences that Gilar (Analytical Biochemistry 298, 196-206 (2001))'s Xterra MS C18 is a silica based support. It would have been obvious to use EDTA as an additive in Gilar (Analytical Biochemistry 298, 196-206 (2001)) because Gjerde (U.S. Patent Pub. 2002/0185441) discloses that EDTA is an additive that can protect and restore a column. It would have been obvious that Gilar (Analytical Biochemistry 298, 196-206 (2001))'s Xterra MS C18 is a silica based support because A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 evidences that Gilar (Analytical Biochemistry 298, 196-206 (2001))'s Xterra MS C18 is a silica based support.

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Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilar (Analytical Biochemistry 298, 196-206 (2001)) in view of A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 and Gjerde (U.S. Patent Pub. 2002/0185441) as applied to claims 1-14 and 16 above, and further in view of Gjerde (U.S. Patent No. 6,524,480). At best, the claim differs from Gilar (Analytical Biochemistry 298, 196-206 (2001)) in view of A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 and Gjerde (U.S. Patent Pub. 2002/0185441) in reciting use of isocratic conditions. Gjerde (U.S. Patent No. 6,524,480) (column 32, lines 10-17) discloses that the combination of isocratic and gradient elution enhances resolving power. It would have been obvious to use isocratic conditions in Gilar (Analytical Biochemistry 298, 196-206 (2001)) in view of A Review of Waters' New Hybrid Particle Technology and Its Use in High Performance Liquid Chromatography (HPLC) 1999 pages 1-4 and Gjerde (U.S. Patent Pub. 2002/0185441) because Gjerde (U.S. Patent No. 6,524,480) (column 32, lines 10-17) discloses that the combination of isocratic and gradient elution enhances resolving power.

Claims 15, 17, and 18 are withdrawn from consideration as being drawn to non-elected species.

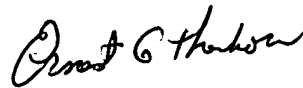
The remarks urge searching each additive, each modifier, and each component would not be a burden on the examiner. However, searching each additive, each modifier, and each component and the different issues of patentability with regard to each additive, each modifier, and each component would be an enormous burden on

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the examiner. As such, the election of species requirements have been reconsidered, deemed proper, and made final.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (571) 272-1149. The official fax number is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT
March 22, 2005